IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hiroshi Mikitani et al.

Application No.: 09/653,163	Confirmation No.: 5466
Filed: September 1, 2000	Art Unit: 3628
For: LOTTERY SYSTEM UTILIZING ELECTRONIC MAIL	Examiner: I. N. Borissov

REPLY BRIEF

MS Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

This is a Reply Brief in response to Examiner's Answer dated July 7, 2009. All arguments presented within the Appeal Brief of April 9, 2009 are incorporated herein by reference. Additional arguments are provided herein below.

Application No. 09/653,163   Docket No.: KAK-0001
Reply Brief dated September 8, 2009
Reply to Examiner Answer of July 7, 2009

I.   STATUS OF CLAIMS

Within the Final Office Action of July 2, 2007:

Page 2 of the Final Office Action indicates a rejection of claims 1-4, 6, 8-13 and 16-22 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0161589 to Strandberg in view of US Patent No. 5,983,196 to Wendkos.

Page 8 of the Final Office Action indicates a rejection of claims 8 and 9 under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0161589 to Strandberg in view of US Patent No. 5,983,196 to Wendkos and further in view of US Patent No. 6,024,641 to Sarmo.

Page 9 of the Final Office Action indicate a rejection of claim 23-26 under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0161589 to Strandberg in view of US Patent No. 5,983,196 to Wendkos and further in view of US Patent No. 6,193,605 to Libby et al.

Thus, the status of the claims is as follows:

Claim 1-4, 6, 8-13 and 16-26 (Rejected)

Claim 5, 7, and 14-15 (Canceled)

No claims are indicated within the Final Office Action to contain allowable subject matter.

The claims on appeals are claims 1-4, 6, 8-13 and 16-26.

II.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-4, 6, 8-13 and 16-22

Claims 1-4, 6, 8-13 and 16-22 have been rejected under 35 U.S.C. §103(a) as unpatentable over Strandberg (US 2002/0161589) in view of Wendkos (US 5,983,196).

Claims 8 and 9

Claims 8 and 9 are rejected under 35 U.S.C. §103(a) as unpatentable over Strandberg (US 2002/0161589) in view of Wendkos (US 5,983,196) and further in view of Sarno (US 6,024,641).

Claims 23-26

Claims 23-26 are rejected under 35 U.S.C. §103(a) as unpatentable over Strandberg (US 2002/0161589) in view of Wendkos (US 5,983,196) and further in view of Libby et al. (US 6,193,605).

III.   ARGUMENTS

(10.01) Claims 1-4, 6, 8, 9, 12, and 13

1. Examiner's errors in determining that Wedkos fails to teach means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery. (Examiner's Answer (EA) pp10-12, and Appeal Brief (AB) pp. 12-15)

In response to the Applicants' arguments that "Wendkos fails to teach means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery," that is, Wendkos does not limit the customers before the lottery is performed," the Examiner argues that Wendkos explicitly discloses this feature. Specifically the Examiner asserts that Wendkos teaches that only selected participants who have made certain amount of purchases, are selected to participant in promotion/lottery (C. 10. L. 35-53), quoting the following paragraph:

> A particularly powerful use of this capability is found under the circumstance when a sponsor of a promotional program <u>wishes to identify his "good customers." A good customer might be defined as a customer who has made three purchases of a particular type in the last thirty days. By invoking the name and address capture routine of FIGS. 11A and 11B, only for those participants who have registered certificates for the three purchases in question within thirty days, the sponsor of the program can receive a list of names and addresses which contain only those customers who have made such purchases.</u> In the prior art, a sponsor of a program was limited to either capturing everyone's name and address, or no one's. This permits the name and address capture to be customized to the needs of the particular sponsor. As a result, since the cost of direct mailings is very high, <u>the sponsor can customize a mailing to only his best purchasers, however the sponsor may define that term.</u> As a result, a sponsor will not waste resources in conducting a direct mailing to customers who might not be responsive to his entreaties. (Emphasis added by the Examiner)

However, the paragraph does not teach that feature as the Examiner asserts. Examiner appears to misunderstand the invention disclosed in Wendkos. In Summary of the Invention of Wendkos describes as follows:

> In one implementation, a peel open certificate is provided for inclusion in packaging of items to be sold or for inclusion as part of a display or for dispensing at check-out by merchants dealing in the goods or services to be promoted by the incentive award program. The inside of the certificate contains a telephone number (preferably a toll free telephone number), instructions for using the certificate and a certificate number which is unique to each certificate. The instructions direct a participant in the program to dial the toll free telephone number where the user is prompted to enter the ten digit telephone number under which the user desires to register the certificates. A computer interfaces with a voice response unit to handle the incoming calls automatically. An entry is created in a database for each user and the database entry is utilized to track the awards for that particular user. (Emphasis added)

In summary, Wendkos teaches that purchasers of an item including a peel open certificate are instructed (invited) to dial the toll free telephone number, and if a computer receives a call from a purchaser, the computer handles the incoming call automatically. Thus, in Wendkos, potential participants in an award program are purchasers of the item, but only purchasers who dial the toll free telephone number are participants in the incentive award program.

This teaching (entry of only purchasers who make a call is created and the database entry is utilized, that is, only purchasers who make a call are participant of the incentive award program) is consistent throughout the specification of Wendkos. For example, a smart poll capability 810 is invoked by a call from the call flow table (C. 8, line 55 through C.9, line 6, specifically, C. 9, lines 3-4). A smart talk capability 820 is invoked by a call from the call flow table (C. 9, lines 40-52, specifically lines 45-46). A Q & A process begins with a call from the call flow table (C. 9, line 64 through C.10, line14, specifically, C.10, lines 6-8). A smart win capability 840 begins with a call

from the call flow table (C. 10, line 55 through C.12 line 8). As to a smart award capability 850, please refer to C.12, lines 9-47). (Please note that as shown in FIG. 4, the "call flow table" is a table including information about a set of modules which specify the order in which interactions with the participant occur. That is, when receiving an incoming call from a purchaser, interactions initiated by a computer are performed based on the call flow table. Refer to C. 7, line 50 through C. 8 line 27, for the "call flow table").

Since purchasers (not the computer system) have one way option to participate in an incentive award program, and the computer system described in Wendkos does not limit the participants. Thus, Wendkos fails to disclose, teach or suggest "means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery."

The "smart win process" that Examiner points out is not a process of limiting participants from whom winners are selected, but a process of selecting award winners, that is, in the process of selecting award winners, the participants are not selected before the award winners are selected.

Further, please note that purchasers have choices as to whether or not to buy the item, so that the computer system disclosed in Wendkos cannot limit the purchasers, without regards to their choices. Further the purchasers who have made certain amount of purchases are just potential participants not actual participants. The computer system disclosed in Wendkos does not limit participants in advance, that is, in order to be participants, the potential participants need to dial the toll free number. Thus, the computer system disclosed in Wendkos has nothing to do with limiting the potential participants.

Thus, Examiner errs in determining that "Wendkos teaches that only selected participants who have made certain amount of purchases, are selected to participant in promotion/lottery."

2. Examiner's error in determining that Wendkos explicitly teaches identifying a specific group of customers (EA p. 11 and AB pp. 13-12).

In response to the Applicants' arguments that "Examiner errs in determining that Wendkos explicitly teaches identifying a specific group of customers," the Examiner maintains that Wendkos discloses this feature, quoting part of disclosure of Wedkos (C. 10, L. 35-53) as follows:

> A particularly powerful use of this capability is found under the circumstance **when a sponsor of a promotional program** <u>wishes to identify his "good customers." A good customer might be defined as a customer who has made three purchases of a particular type in the last thirty days. By invoking the name and address capture routine of FIGS. 11A and 11B, only for those participants who have registered certificates for the three purchases in question within thirty days, the sponsor of the program can receive a list of names and addresses which contain only those customers who have made such purchases</u>. In the prior art, a sponsor of a program was limited to either capturing everyone's name and address, or no one's. **This permits the name and address capture to be customized to the needs of the particular sponsor. As a result, since the cost of direct mailings is very high, the sponsor can customize a mailing to only his best purchasers**, however the sponsor may define that term. As a result, a sponsor will not waste resources in conducting a direct mailing to customers who might not be responsive to his entreaties. (Emphasis added). Nothing about limiting participants or specifying a specified group is taught in the underlined portion. (Emphasis added)

In the sentences that the Examiner underlines in the Examiner's Answer (see underlined sentences in the above quotation), "a case where <u>a sponsor of a promotional program</u> wishes to identify his good customers" is described. Thus, <u>no teaching about limiting participants of specifying a specific group **for the incentive award program**</u> is made therein. It only teaches that customer information may be customized for the sponsor or used for selection of customers for **direct mailings.** See the above bolded sentences in the above quotation. There is nowhere in Wendkos to teach that participants are limited or a specific group is identified for the incentive award program.

Also, in view of the context of the disclosure of Wendkos invention (that is, purchasers of an item decide whether to dial the toll free number, and when a purchaser dial the number, the computer disclosed in Wendkos receives an incoming call), Applicants believe that, in Wedkos, no consideration about limiting participants or identifying a specific group <u>for the incentive award program</u>, is made.

3. Examiner's errors in determining that participants are selected from the customer information. (EA pp. 12-13 and AB pp. 13-15).

In response to Applicants' arguments that Wendkos fails to teach that participants are selected from the customer information, Examiner asserts that <u>information collected</u> about the customers in Wendkos's system <u>is utilized for promotional program/lottery</u>; <u>based on the customer information, the participants are selected;</u> the promotion message are played; and awards are distributed in a controlled manner.

As discussed above, in Wendkos, purchasers have a choice (in a unilateral approach manner) to dial the toll free number. Unless the purchasers dial the number, no incentive award program is carried out, since the purchase information is not entered in the computer system unless the purchaser dials the number. That is, there is no participant in an incentive award program if no call from the purchasers is made. Thus, the participants are not selected by the system described in Wendkos. Thus, Examiner misstates the invention disclosed in Wendkos (see the sentence underlined by the Examiner for misstatements). The portions of the Wendkos quoted by the Examiner (FIGS. 11B, 12; C. 9, L. 54-58; C. 10, L. 35-39; C. 11, L. 1-5) fail to teach that the participants are selected in advance for the incentive award program. **<u>In Wendkos, award winners may be selected but participants are not selected in advance.</u>**

In order to support his position, Examiner also quotes a paragraph of C. 10, L. 56-67 as follows:

As with the other processes, the smart win process begins with a call from the call flow table (1200) passing state and/or participant information. In this case, it may also pass certificate information such as a certificate ID (1210). With certificate ID information, certificate information from the certificate data base may be retrieved. A particular award algorithm is selected (1220) based on certificate information and/or participant information as discussed more hereinafter. If the participant is a winner, the award amount is credited (1230) and the process returns. The function of the smart win process is to make awards to certain participant in a controlled manner.

However, this paragraph only teaches that the smart win process makes awards to certain participant in a controlled manner. It fails to teach that participants are selected "**in advance** for the incentive award program (lottery)". Thus, the Examiner's arguments are not persuasive.

4. Failure to teach a system… comprising: … allocating uniquely a reply electronic mail address to each of participants. (EA pp. 13-14 and AB pp. 13-14).

In response to Applicants' arguments that Examiner errs in determining that Strandberg teaches a… system… comprising:… allocating uniquely a reply electronic mail address to each of participants, the Examiner asserts that the main purpose of allocating uniquely said reply electronic mail addresses to each of said participant is that said reply electronic mail addresses are different from each other (claim language), or that each participant can be recognized. Further, the Examiner asserts that Strandberg teaches allocating a unique ID (to be inserted into participants' reply e-mail) to each of the participants so that each participant can be recognized by this ID in his/her reply e-mail [0019], and accordingly so as the purpose of allocating the unique ID in Strandberg's system is the same as allocating the unique e-mail address in the applicants' invention. The Examiner maintains that teaching of Standberg is equivalent to the inventive feature in question.

As the Examiner implicitly admits, Strandberg fails to teach a system… comprising: … allocating uniquely a reply electronic mail address to each of participants. However, Examiner asserts that the purpose of allocating the unique ID in Strandberg's system is the same as allocating

the unique e-mail address in the applicants' invention so that the teaching of Strandberg is equivalent to the inventive feature in question.

> MPEP2141:
> The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "'[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" KSR, 550 U.S. at ___, 82 USPQ2d at 1396. (Emphasis added)

In this case, the Examiner fails to clearly articulate the reason(s) why the claimed invention would have been obvious when "the purpose of allocating the unique ID in Strandberg's system is the same as allocating the unique e-mail address in the applicants' invention" or "teaching of Wedkos is equivalent to the inventive feature in question". Thus, the reasoning of the rejection is mere conclusory statements. Thus, the rejection on obviousness cannot be sustained. Accordingly, a prima facie case of obviousness has not been established.

Further, the Examiner fails to articulate reasons why the teaching of Strandberg is equivalent to the inventive feature in question when the purpose of allocating the unique ID is the same as that of allocating the unique e-mail address.

Applicants respectfully request for citation of legal authority for supporting the Examiner's contention that an element shown in prior art is equivalent to that of the present invention when the purpose of the element is substantially the same as that of prior art. Even thought the purpose of elements is the same as that shown in a reference(s), there are plenty of cases where the teaching of reference is not equivalent to the inventive feature in question. Thus, as to this point, prima facie case of the obviousness has not been established, either.

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Moreover, the Examiner ignores an element of claim 1, that is "means for recognizing an application for the lottery from each of said participants by receiving <u>a second electronic mail sent back to said reply electronic mail address</u>." Thus, in the present invention, applications from participants are recognized by receiving e-mail at the reply electronic mail address which is allocated by the lottery system according to the present invention. In the applied art, applications from participants cannot be recognized based on participants' e-mail address or by <u>merely receiving e-mail</u> in which ID is embedded (written).

(10.02) Claims 10, 11 and 18

1. Examiner's error in determining that Wendkos teaches means for limiting the customers so as to specify a main group for performing the lottery (EA pp. 13-14 and AB p.16).

In response to Applicants' arguments that "the Examiner errs in determining that Wendkos teaches means for limiting the customers so as to specify a main group for performing the lottery…", Examiner notes that this argument essentially repeats the arguments presented above, therefore, the responses presented by the Examiner above are equally applicable to the remaining applicants' arguments. With regard to this point, please refer to the above arguments regarding Claims 1-4, 6, 8, 9, 12, and 13.

2. Examiner's error in determining that Strandbederg teaches means for uniquely allocating a keyword to be entered in a page of a URL, to each of participant (EA p. 14 and AB pp.16-17).

In response to Applicants' argument that Examiner errs in determining that Strandberg teaches means for uniquely allocating a keyword to be entered in a page of a URL, to each of participants, the Examiner notes that this argument essentially repeats the arguments presented above, therefore, the responses presented by the Examiner above are equally applicable to the remaining applicants' arguments.

However, the applied art fails to disclose, teach or suggest "URLs are different from each other." Further, this feature is not recited in the claims the Examiner refers to. Applicants respectfully request that the Applicants' arguments with respect to this feature be considered. Otherwise, withdrawal of the rejection and allowance of the claim is respectfully requested.

(10.03) Claim 16

Although Examiner asserts that the applicant arguments essentially repeat that the arguments presented by the examiner above are equally applicable to the remaining applicants arguments, the applicants have made the arguments set forth below in the Appeal Brief.

1. Examiner's error in determining that Wendkos teaches means for limiting the customers so as to specify a main group for performing a lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C11, L. 15-C. 12, L 8) (EB pp. 15 and AB p. 17).

As discussed above, in the paragraphs that the Examiner indicates, good customer information used for direct mailings and an award algorithm (smart win process) that selects award winners is described, but there is no description of limiting the customers stored in the database in advance so as to specify particular participants for a lottery. Thus, Wendkos fails to disclose, teach or suggest "limiting the customers stored in the database in advance so as to specify particular participants for a lottery." Thus, Examiner fails to establish a *prima facie* case of obviousness.

2. Examiner's error in determining that Strandberg teaches a method ... comprising: allocating uniquely an electronic mail address to each of participants [0018], [0019] (EB pp. 15 and AB pp. 17-18).

Strandberg teaches that "the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address."

As discussed above with respect to claim 1, none of the applied art, alone or in combination, does not disclose, teach or suggest "allocating uniquely a reply electronic mail address to each of said specified participants so that the reply electronic mail addresses are different from each other." Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

Claim 17

Although Examiner asserts that the applicant arguments essentially repeat that the arguments presented by the examiner above are equally applicable to the remaining applicants arguments, the applicants have made the arguments set forth below in the Appeal Brief.

1. Examiner's error in determining that Wendkos teaches means for limiting the customers so as to specify a main group for performing a lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C11, L. 15-C. 12, L 8) (EB pp. 15 and AB p. 18).

As discussed above, in the paragraphs that the Examiner indicates, good customer information used for direct mailings and an award algorithm (smart win process) that selects award winners, is described, but there is no description of limiting the customers stored in the database in advance so as to specify particular participants for a lottery. Thus, Wendkos fails to disclose, teach or suggest "means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery." Thus, Examiner fails to establish a *prima facie* case of obviousness.

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2. Examiner's error in determining that Strandberg teaches means for uniquely allocating a URL to each of said participants so that the URLs are different from each other [0018],[0019] (EB pp. 15 and AB pp. 18-19).

Strandberg teaches that "[t]his e-mail message may contain information such as the information requested by the interested party, information concerning an account delinquency, a request for the interested part to call a particular telephone number and/or a Uniform Resource Locator (URL) address of a particular Internet –World Wide Web address, including a unique ID to link to an interested party database record."

However, although Strandberg teaches that e-mail message may contain information such as URL address of a particular Internet, it does not teach "the URLs are different from each other". Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

<u>**Claim 19**</u>

Although Examiner asserts that the applicant arguments essentially repeat that the arguments presented by the examiner above are equally applicable to the remaining applicants arguments, the applicants have made the arguments set forth below in the Appeal Brief.

1. Examiner's error in determining that Wendkos teaches means for limiting the customers so as to specify a main group for performing a lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C. 11, L. 15-C. 12, L8) (EB pp. 15 and AB p. 19).

As discussed above, in the paragraphs that the Examiner indicates, good customer information used for direct mailings and an award algorithm (smart win process) that selects award winners, is described, but there is no description of limiting the customers stored in the database in

advance so as to specify particular participants for a lottery. Thus, Wendkos fails to disclose, teach or suggest "means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery." Thus, Examiner fails to establish a *prima facie* case of obviousness.

2. Examiner's error in determining that Strandberg teaches means for providing at least one electronic mail address [0018] and means for allocating uniquely the at least one electronic mail address to each one of the specified participants so that the electronic mail addresses are different from each other [0018], [0019] (EB pp. 15 and AB pp. 19-20).

Strandberg teaches that "the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address."

As discussed above, in Strandberg, the e-mail address in the database 200 is supplied by the customers, but not created (allocated) by the system of Strandberg. Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

Claim 20

Although Examiner asserts that the applicant arguments essentially repeat that the arguments presented by the examiner above are equally applicable to the remaining applicants arguments, the applicants have made the arguments set forth below in the Appeal Brief.

1. Examiner's error in determining that Wendkos teaches limiting the customers so as to specify a main group for performing the lottery (The function of the smart win program is to make awards to certain participant in a controlled manner) (C. 10, L 56-67; C. 11, L. 15-C. 12, L. 8) (EB pp. 15 and AB p. 20).

As discussed above, in the paragraphs that the Examiner indicates, good customer information used for direct mailings and an award algorithm (smart win process) that selects award winners, is described, but there is no description of limiting the customers stored in the database in advance so as to specify particular participants for a lottery. Thus, Wendkos fails to disclose, teach or suggest "limiting the customers stored in the database in advance so as to specify particular participants for the lottery." Thus, Examiner fails to establish a *prima facie* case of obviousness.

2. Examiner's error in determining that Strandberg teaches means for providing at least one electronic mail address and means for allocating uniquely the at least one electronic mail address to each one of the specified participants so that the electronic mail addresses are different from each other [0018], [0019] (EB pp. 15 and AB pp. 20-21).

Strandberg teaches that "the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address."
As discussed above, in Strandberg, the e-mail address in the database 200 is supplied by the customers, but not created (allocated) by the system of Strandberg. Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

Claim 21 and 22

Although Examiner asserts that the applicant arguments essentially repeat that the arguments presented by the examiner above are equally applicable to the remaining applicants arguments, the applicants have made the arguments set forth below in the Appeal Brief.

1. Examiner's error in determining that Wendkos teaches means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers [0019] (EB pp. 15 and AB p. 21).

As discussed above, in the paragraphs that the Examiner indicates, good customer information used for direct mailings and an award algorithm (smart win process) that selects award winners, is described, but there is no description of limiting the customers stored in the database in advance so as to specify particular participants for a lottery. Thus, Wendkos fails to disclose, teach or suggest "means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers." Thus, Examiner fails to establish a *prima facie* case of obviousness.

2. Examiner's error in determining that Strandberg teaches means for assigning said unique access key to said electronic mail address to generate a reply electronic mail address for the lottery after specifying said main group for the lottery [0018], [0019] (EB pp. 15 and AB p. 21).

Strandberg teaches that "the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address."
However, the Examiner ignores the limitation of "replay", and further, in Strandberg, the e-mail address in the database 200 is supplied by the customers but not created (allocated) by the system of Strandberg. Strandberg fails to teach generation of a <u>reply</u> electronic mail address by assigning said unique access key to said electronic mail address. Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

<u>Claims 8 and 9</u>
Exminer's err in determining that claims 8 and 9 have been erroneously rejected under 35 U.S.C. § 103(a) as unpatentble over Strandberg in view of Wendkos and further in view of Sarno (EB pp. 15 and AB pp. 22-23).

Although Examiner asserts that the applicant arguments essentially repeat that the arguments presented by the examiner above are equally applicable to the remaining applicants arguments, the applicants have made the arguments set forth below in the Appeal Brief.

Claim 8

Claim 8 depends on claim 6 which <u>depends on claim 1</u>, and as discussed in the section 1.(a)(1) as to claim 1, Examiner errors in determining that Wendkos teaches means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery [0019]. Also, as discussed in the section 1.(a)(2) as to claim 1, Examiner errors in determining that Strandberg teaches a ... system..., comprising:... allocating uniquely an electronic mail address to each of participants [0018], [0019]. In addition, Sarno fails to disclose, teach or suggest these features. Moreover, the applied art fails to disclose, teach or suggest that "the URL of the page informing of said result is separated into one for a win of a prize and the other for a failure in winning the prize." Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

Claim 9

Claim 9 depends on claim 6 which <u>depends on claim 1</u>, and as discussed in the section 1.(a)(1) as to claim 1, Examiner errors in determining that Wendkos teaches means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery [0019]. Also, as discussed in the section 1.(a)(2) as to claim 1, Examiner errors in determining that Strandberg teaches a ... system..., comprising:... allocating uniquely an electronic mail address to each of participants [0018], [0019]. In addition, Sarno fails to disclose, teach or suggest these features. Moreover, the applied art fails to disclose, teach or suggest that "by entering said access keyword and a destination electronic mail address to which the third electronic mail is sent, into the page informing of said result, the page for the win of the prize or the page of the failure in winning

the prize can be accessed." Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

Claims 23-26

Claims 23-26 have been erroneously rejected under 35 U.S.C. § 103(a) as unpatentable over Strandberg in view of Wendkos and further in view of Libby et al. (EB pp. 15 and AB p. 23-25).

Although Examiner asserts that the applicant arguments essentially repeat that the arguments presented by the examiner above are equally applicable to the remaining applicants arguments, the applicants have made the arguments set forth below in the Appeal Brief.

Claim 23

Claim 23 depends on claim 22 which <u>depends on claim 21</u>, and as discussed in the section 1.(g)(1) as to claim 21, Wendkos fails to disclose, teach or suggest "means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers." Further, as discussed in the above section 1.(g)(2) as to claim 21, Examiner errors in determining that Strandberg teaches that "the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address." Moreover, the applied art fails to teach "said drawing is performed on the basis of the number of said participants of said main group." Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

Claim 24

Claim 24 depends on claim 22 which <u>depends on claim 21</u>, and as discussed in the section 1.(g)(1) as to claim 21, Wendkos fails to disclose, teach or suggest "means for limiting the customers

in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers." Further, as discussed in the above section 1.(g)(2) as to claim 21, Examiner errors in determining that Strandberg teaches that "the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address." Moreover, the applied art fails to teach "said means for conducting the lottery generates random number on the basis of the number of said participants of said main group, thereby obtaining the result of said lottery." Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

Claim 25

Claim 25 <u>depends on claim 21</u>, and as discussed in the section 1. (g)(1) as to claim 21, Wendkos fails to disclose, teach or suggest "means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers." Further, as discussed in the above section 1.(g)(2) as to claim 21, Examiner errors in determining that Strandberg teaches that "the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address." Moreover, the applied art fails to teach "said lottery system further comprising means for recording a result of the lottery; wherein the result of said lottery is previously decided on the basis of the number of said participants of said main group before sending said electronic mail, and wherein said means for conducting the lottery includes means for confirming said unique access key with reference to said means for recording the result of the lottery when receiving said second electronic mail." Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

Claim 26

Claim 26 depends on claim 24 which <u>depends on claim 21</u>, and as discussed in the section 1.

(g)(1) as to claim 21, Wendkos fails to disclose, teach or suggest "means for limiting the customers

in advance so as to specify a main group for performing a lottery, said main group being defined by

at least one of the customers." Further, as discussed in the above section 1.(g)(2) as to claim 21,

Examiner errors in determining that Strandberg teaches that "the interested party database 200 may

contain such information concerning the interested part such as their name, address, telephone

number, account history, and in the preferred embodiment of this invention an electronic mail (e-

mail) address." Moreover, the applied art fails to teach "said means for conducting the lottery

generates random number on the basis of the number of said participants of said main group,

thereby deciding the result of the lottery." Thus, Examiner fails to establish a *prima facie* case of

obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

Dated: September 8, 2009   Respectfully submitted,

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